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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,315	09/05/2003	Asaki Suzuki	788_089 DIV	8216
25191	7590	08/20/2004	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068				SCHWARTZ, JORDAN MARC
		ART UNIT		PAPER NUMBER
				2873

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,315	SUZAKI ET AL. <i>[Signature]</i>	
	Examiner	Art Unit	
	Jordan M. Schwartz	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, that part of the claim stating, "when said ophthalmic lens is a contact lens" renders the claim vague and indefinite because it is not clear as to how to apply this limitation if the lens is not a contact lens. Furthermore, if contact lens is intended as a limitation, as is herein assumed, then it needs to be more positively and distinctly. For purposes of examination the assumed meaning of claim 12 is "A method according to claim 1 wherein said ophthalmic lens is a contact lens and wherein said stable position...said offset amount does not exceed 30⁰" with a similar assumed meaning as to claim 13 depending from claim 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al patent number 6,082,856 in view of Seidner patent number 5,493,350.

Dunn et al discloses the limitations therein including the following: a method for designing an ophthalmic lens (abstract) comprising determining specifications of a temporary lens such that said temporary lens gives optical power required by a wearer (column 11, lines 59-62); applying the temporary lens to a prescribed schematic eye and the schematic eye corresponding to the eye of a wearer (column 11, line 53, column 12, line 1); obtaining an optical characteristic of the optical system consisting of the temporary lens and the schematic eye (column 12, lines 1-4 in that if an analysis is being performed then the analysis will inherently be obtaining an optical characteristic); successively modifying the temporary lens and obtaining successively said optical characteristics corresponding to different configurations of the temporary lens (column 12, lines 5-16 re varying the shape factor of the temporary lens i.e. "different configurations of the temporary lens"); selecting an optimum one of the different configurations which gives an optimum characteristic (column 12, lines 17-28); determining specifications of an intended ophthalmic lens as a final product based on the selected optimum configuration (column 12, lines 17-28). The optical characteristic of Dunn et al will inherently be calculated by one of a wavefront aberration, point spread function, modulation transfer function or resolving power, this being reasonably based upon Dunn et al disclosing performing analysis by tracing the light ray paths through the system.

Dunn et al discloses as is set forth above but discloses the temporary lens centered on the visual axis and not at a position corresponding to a stable position on an eye. Seidner teaches that in a method for designing an ophthalmic

lens comprising determining specifications of a temporary lens such that said temporary lens gives optical power required by a wearer and obtaining successive optical characteristics corresponding to different configurations of the temporary lens and selecting an optimum one of the different configurations which gives an optimum characteristic and determining specifications of an intended ophthalmic lens as a final product similar to the method of Dunn et al (column 2, lines 26-54, column 4, lines 38-46 column 5, lines 7-30 and column 6, line 54) that it is desirable to position the temporary lens at a position corresponding to a stable position on an eye for the purpose of obviating the necessity of centering the lens and for providing a lens located at a more naturally fitting position on an eye (column 2, lines 37-42, column 4, line 62 to column 5, line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the temporary lens of Dunn et al as at a position corresponding to a stable position on an eye and not centered on the visual axis since Seidner et al teaches that in a method similar to that of Dunn et al it is desirable to have the temporary lens located at a position corresponding to a stable position on an eye for the purpose of obviating the necessity of centering the lens and for providing the lens to be located at a more naturally fitting position on an eye.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon patent number 6,224,211 in view of Dunn et al patent number 6,082,856.

Gordon discloses the limitations therein including the following: a method for designing an ophthalmic lens (column 1, lines 4-6, column 2, line 15)

comprising determining specifications of a temporary lens such that said temporary lens gives optical power required by a wearer (column 4, lines 44-50). The temporary lens will inherently be located at a stable position on an eye of a user, this being reasonably based upon Gordon disclosing the temporary lens located on the eye of an intended user to obtain emmetropia similar to that of the claimed invention (column 4, lines 44-50); effecting emmotropization of the optical system of the schematic eye and the temporary lens (column 4, lines 44-50); obtaining an optical characteristic of the optical system consisting of the temporary lens and the eye (column 4, lines 44-50, the optical characteristic being the optical power to obtain emmetropia); obtaining successive optical characteristics corresponding to different configurations of the temporary lens (column 2, line 11, column 4, line 43 to column 5, line 35); selecting an optimum one of the different configurations which gives an optimum characteristic (column 5, lines 5-14); determining specifications of an intended ophthalmic lens as a final product based on the selected optimum configuration (column 5, lines 5-14); the optical characteristic calculated by resolving power (column 5, lines 5-14); and emmetropization effected by changing an optical power of the corrective lens (column 4, lines 44-50).

Gordon et al discloses as is set forth above but discloses the temporary lens being applied to an eye of a user and not to a schematic eye. Dunn et al teaches that in a method similar to that of Gordon et al (see the Dunn et al in view of Seidner rejection above and Dunn et al column 11, line 48 to column 12, line 28) that it is desirable to apply the temporary lens to a schematic eye for the

purpose of providing an improved method of designing an ophthalmic lens having improved aberration control (column 3, lines 45-48, column 11, line 48 to column 12, line 28). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the temporary lens of Gordon et al as being placed on a schematic eye as opposed to an eye of a user since Dunn et al teaches that in a method similar to that of Gordon et al it is desirable to apply the temporary lens to a schematic eye for the purpose of providing an improved method of designing an ophthalmic lens having improved aberration control. Gordon et al further discloses as is set forth above including providing a series of temporary lens to be modified to obtain the successive optical characteristic but does not specifically disclose the modification of a single temporary lens to obtain the successive optical characteristic. Dunn et al further teaches that in a method of designing ophthalmic lenses similar to that of Gordon et al (see the Dunn et al in view of Seidner rejection above and Dunn et al column 11, line 48 to column 12, line 28) that the successively obtaining the optical characteristic can be achieved by successively modifying a single temporary lens (as opposed to using a series of temporary lenses) for the purpose of obtaining the optimum of the desired optical characteristic (column 12, lines 5-27 re varying the shape factor of the temporary lens i.e. "different configurations of the temporary lens"). Therefore, it would have been further obvious to a person of ordinary skill in the art at the time the invention was made to modify a single temporary lens to obtain the successive optical characteristic since Dunn et al further teaches of the desirability of such a feature in a method

of designing ophthalmic lenses similar to that of Gordon et al for the purpose of determining the optimum of the desired optical characteristic.

Allowable Subject Matter

Claims 12-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claims 12-13, none of the prior art either alone or in combination, disclose or teach of the claimed method of designing an ophthalmic lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed determining of the stable position by an offset amount represented by an angle defined by the intersection of the of the optical axis of the temporary lens and the optical axis of the eye with the offset amount being determined by a plurality of offset amounts as claimed and the offset amount not exceeding 30 degrees.

Response to Arguments

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the newly applied grounds of rejection set forth above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz
Primary Examiner
Art Unit 2873
August 18, 2004